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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/823,211
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	First Named Inventor	Haag et al.
	Art Unit	1614
	Examiner Name	V. Balasubramanian
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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT	
Firm or Individual name	Brian C. Remy
Signature	
Date	November 5, 2004

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PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application

Rainer Haag et al.

Group: 1624

Serial No. 10/823,211, filed April 13, 2004

Examiner: V. Balasubramanian

For: **N-MONOACYLATED DERIVATIVES OF O-PHENYLENEDIAMINES,
THEIR ANALOGS AND THEIR USE AS PHARMACEUTICAL AGENTS**

RESPONSE TO RESTRICTION REQUIREMENT

Nutley, New Jersey 07110
November 5, 2004

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants respectfully request consideration of the following remarks in response to the Restriction Requirement issued October 5, 2004 in connection with the above-identified application. This response is due November 5, 2004.

Claims 1 to 30 are pending. The claims have been divided into three groups as set forth below:

- I. Claims 1 to 30, drawn to the compounds, compositions, methods of making and methods of using the compounds of formula I, wherein X^1 and X^2 are both nitrogen, classified in class 544, subclasses 326, 328, and class 514, subclass 256.
- II. Claims 1 to 30, drawn to the compounds, compositions, methods of making and methods of using the compounds of formula I, wherein one of X^1 or X^2

is nitrogen and the other carbon, classified in class 546, subclasses 268.01, 307, and class 514, subclass 352.

- III. Claims 1 to 30, drawn to the compounds, compositions, methods of making and methods of using the compounds of formula I, wherein X¹ and X² are both carbon, classified in class 564, subclasses 123, 244 and class 514, subclass 615.

The Office Action indicates that restriction is proper because the compounds delineated in each of the three groups are structurally dissimilar compounds that lack a common core (e.g. pyrimidine versus pyridine versus benzene cores). Consequently, according to the Examiner, the groups have different classifications, require separate prior art searches, can be made and used independently, and a reference anticipating one group would not render the other groups obvious.

Applicants hereby provisionally elect with traverse Group III relating to the benzene (or phenyl) compounds of claims 1-30 for prosecution on the merits. Applicants also provisionally elect with traverse the species benzofuran-2-carboxylic acid (2-amino-phenyl) amide of claim 3 if no generic claim is held allowable.

In addition, it is respectfully noted that the Applicants elected Group III in the parent application but point out that the Examiner withdrew claims 12-16 as nonelected even though claims 12-13 and the majority of claim 14 were drawn to the benzene core of Group III (*i.e.*, the 4,5-dichloro-phenyl compounds). Accordingly, it is respectfully requested that in this application the Examiner not withdraw claims 12-13 or that portion of claim 14 drawn to Group III if the restriction requirement is maintained.

The restriction requirement is traversed because Applicants believe that no serious burden exists to search and examine the invention as a whole (MPEP § 803). Restriction between structurally diverse compounds is permitted only when there is a serious burden on the Patent Office to examine the invention as a whole. If the search and examination of the

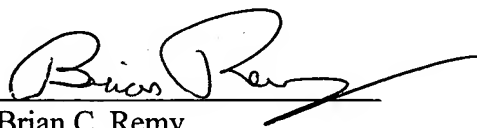
Serial No. 10/823,211
Filed: April 13, 2004

entire application can be made without serious burden, the Examiner must examine it on the merits. Applicants note that all three of the groups delineated in the Office Action are classified in Class 514. In addition, because all of the compounds are useful for the same purpose, issues related to search and examination would be the same for all of the claimed compounds. Accordingly, the Applicants respectfully request reconsideration and withdrawal of the restriction requirement and examination of the application in its entirety.

The foregoing is submitted as a full and complete response to the restriction requirement. Early and favorable consideration of the entire application is respectfully requested. No additional fees are believed due with the filing of this response; however, the Director is hereby authorized to charge any additional fees, or credit any overpayment, to Deposit Account No. 08-2525.

If the Examiner believes any informalities remain in the application which may be corrected by Examiner's Amendment, or if there are any other issues which can be resolved by telephone interview, a telephone call to the undersigned attorney at (973) 235-6516 is respectfully requested.

Respectfully submitted,



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